

The opinion in support of the decision being entered
today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM HSIAO-YU KU, JOHN SHIH-YUAN WANG,
DEREK WAN HOK HO, and JOEY ALLEN PERRY

Appeal 2007-0262
Application 09/925,258
Technology Center 2100

Decided: August 30, 2007

Before JOSEPH F. RUGGIERO, LANCE LEONARD BARRY, and
MAHSHID D. SAADAT, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of
claims 1-23. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' disclosed invention relates to a multi-window display environment in which user alert signals are generated whenever an underlying display window requires user attention. Various types of alert signals, such as audio signals, video signals, and combinations thereof, can be specified by the user. An alert repeat interval may also be specified by a user to define an elapsed time between successive alert signals.

(Specification 2-3).

Claim 1 is illustrative of the invention and it reads as follows:

1. A method for processing a display of an entry panel window on a display device of a user terminal, said entry panel window being selectively caused to appear on said display device to enable input of information in order to effect a continuation of an application coupled to said user terminal from a remote server, said method comprising:

enabling a user to specify entry panel window parameters, said entry panel window parameters being selectively applicable for defining predetermined characteristics associated with a display of said entry panel window;

detecting a receipt of a request at said user terminal from said application at said remote server to present an entry panel window on said display device;

displaying said entry panel window received from said remote server in accordance with said entry panel window parameters specified by said user; and

enabling said input of information by said user into said entry panel window in order to effect said continuation of said application.

The Examiner relies on the following prior art references to show unpatentability:

Trueblood

US 5,675,755

Oct. 7, 1997

Wilks	US 6,246,407 B1	Jun. 12, 2001
Ohmori	US 6,292,620 B1	Sep. 18, 2001 (filed Aug. 13, 1999)

Claims 1, 2, 5, 11, 12, 15, 22, and 23 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Trueblood. Claims 3, 4, 6-10, 13, 14, and 16-21 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner offers Trueblood alone with respect to claim 21, adds Wilks to Trueblood with respect to claims 3, 4, 13, and 14, and adds Ohmori to Trueblood with respect to claims 6-10 and 16-20.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief and Answer for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

(i) Under 35 U.S.C § 102(a), does Trueblood have a disclosure which anticipates the invention set forth in claims 1, 2, 5, 11, 12, 15, 22, and 23?

(ii) Under 35 U.S.C § 103(a), with respect to appealed claim 21, has the Examiner established a prima facie case of obviousness based on Trueblood alone?

(iii) Under 35 U.S.C § 103(a), with respect to appealed claims 3, 4, 13, and 14, would one of ordinary skill in the art at the time of the invention

have found it obvious to combine Trueblood and Wilks to render the claimed invention unpatentable?

(iv) Under 35 U.S.C § 103(a), with respect to appealed claims 6-10 and 16-20, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Trueblood and Ohmori to render the claimed invention unpatentable?

PRINCIPLES OF LAW

1. ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless

of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

2. OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

ANALYSIS

35 U.S.C. § 102(a) REJECTION

With respect to the 35 U.S.C. § 102(a) rejection of independent claims 1, 11, and 23 based on the teachings of Trueblood, the Examiner indicates (Answer 4 and 8-11) how the various limitations are read on the disclosure

of Trueblood. In particular, the Examiner directs attention to the illustrations in Figures 2 and 13A of Trueblood, as well as the disclosure at column 6, lines 24-49 and column 7, lines 13-19 of Trueblood.

Appellants' arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Trueblood so as to establish a prima facie case of anticipation. Initially, Appellants contend (Br. 11-12) that the "always on top" window feature of Trueblood teaches away from Appellants' claimed invention since a user could not work a second window application while waiting for a first window log-in screen since it would be at least partially blocked by the "always on top" first window. Aside from the fact that a "teaching away" argument is inappropriate in an anticipation rejection, we agree with the Examiner that Appellants' argument inaccurately characterizes the disclosure of Trueblood. As pointed out by the Examiner (Answer 9), Trueblood provides (e.g., Figure 2) for the full non-overlapping display of multiple "always visible" windows, thereby permitting a user to work multiple applications.

We also agree with the Examiner (Answer 9-10) that Appellants' argument (Br. 12) that Trueblood does not disclose the display of a log-in panel in which a user is requested to input identification information in order to continue with an accessed application is not commensurate with the scope of the claimed invention. As argued by the Examiner, the language of each of the appealed independent claims 1, 11, and 23 does not require a "log-in" panel window but, rather, merely an "entry" panel window. We find no error in the Examiner's interpretation of the displayed windows (e.g. col. 6, ll. 24-27) in Trueblood which require user entry of information as

corresponding to the “entry” panel windows as claimed. It is our opinion that Appellants’ arguments improperly attempt to narrow the scope of the claims by implicitly adding disclosed limitations which have no basis in the claims. *See In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

We further find to be without merit Appellants’ argument which attempts to distinguish the claimed request receipt detection feature from the disclosure of Trueblood. According to Appellants (Br. 12-13), in contrast to the language of the appealed claims which requires the detection of the receipt of a request from a server to a user terminal for display of a entry panel window, Trueblood discloses the opposite, i.e., requests are made from a user terminal to a server for performance of a particular operation.

In the first instance, we find no error in the Examiner’s stated position (Answer 10) that any request by a user to a server for access to an application will result in a request by the server to the user terminal to display the necessary windows to process a particular application. For example, the “event” messages disclosed by Trueblood (e.g. col. 5, ll. 56-64) as being communicated from a server to a user terminal in a response to a user request for application access would, in our view, be reasonably considered to be “requests” for information to be entered into the display windows for the requested application.

Secondly, our review of Appellants’ disclosure finds no specific identification of the presentation of a log-in screen on a user terminal resulting from a communication between a user terminal and a server as being a “request.” Accordingly, we fail to see why the communications from Trueblood’s server to the user terminal, such as the previously

discussed event messages, would not be considered to be “requests” at least as much as the server to user terminal communications described by Appellants would be considered “requests.”

We similarly find to be unpersuasive Appellants’ contention (Br. 13-14) that Trueblood lacks any disclosure of the claimed feature of enabling user input of information into the entry panel window to effect continuation of the application. We agree with the Examiner (Answer 10-11) that, at the very least, Trueblood’s teaching (col. 6, ll. 24-27) of enabling a user to enter information into displayed entry panel windows to perform such tasks as moving and resizing windows and starting a new application would satisfy such enabling feature, at least in the manner broadly set forth by Appellants.

In view of the above discussion, since all of the claimed limitations are present in the disclosure of Trueblood, the Examiner’s 35 U.S.C. § 102(a) rejection of independent claims 1, 11, and 23, as well as dependent claims 2, 5, 12, 15, and 22 not separately argued by Appellants, is sustained.

35 U.S.C. § 103(a) REJECTION

Appellants’ arguments (Br. 14, 15) in response to the Examiner’s obviousness rejection of dependent claims 3, 4, 13, and 14 based on the combination of Trueblood and Wilks initially reiterate those arguments made alleging the deficiencies of Trueblood in disclosing the claimed “detecting” and “enabling” features. For all of the reasons discussed, *supra*, we find such arguments to be unpersuasive.

We also agree with Examiner (Answer 12) that the teaching of Wilks (col. 5, ll. 4-30) of bringing displayed windows into and out of focus at predetermined intervals satisfies the claimed intermittent window display

feature. We further find no error, and we find no convincing arguments to the contrary from Appellants, in the Examiner's finding that the intermittent window display feature taught by Wilks would serve as an obvious enhancement to the system of Trueblood. As taught by Wilks, the intermittent window display periodically directs a user's attention to the intermittently displayed window without interfering with other displayed program windows.

For the above reasons, since it is our opinion that the Examiner has established a prima facie case of obviousness which has not been overcome by any convincing arguments from Appellants, the Examiner's 35 U.S.C. § 103(a) rejection of dependent claims 3, 4, 13, and 14 based on the combination of Trueblood and Wilks is sustained.

Turning to a consideration of the Examiner's 35 U.S.C. § 103(a) rejection of dependent claims 6-10 and 16-20 in which the Ohmori reference has been applied to Trueblood, we sustain this rejection as well. As with the previously discussed rejection of claims 3, 4, 13, and 14, although Appellants contend (Br. 15) that Ohmori lacks a disclosure of the claimed "detecting" and "enabling" features, these features are disclosed by Trueblood. We also find no error in the Examiner's finding of obviousness to the skilled artisan of applying the audio and video alert teachings of Ohmori to Trueblood for all of the reasons articulated by the Examiner at pages 7 and 12 of the Answer.

Lastly, we also sustain the Examiner's 35 U.S.C. § 103(a) rejection of dependent claim 21 based on Trueblood alone. Appellants have made no separate argument with the respect to the claimed wireless device features of this claim. Instead, Appellants' arguments reiterate the contention that

Trueblood lacks the claimed “detecting” and “enabling” features, argument which, as discussed previously, we find to be unpersuasive.

CONCLUSION

In summary, we have sustained the Examiner’s rejections of all the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-23 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv)(effective September 13, 2004).

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AFFIRMED

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